

Remarks

Reconsideration of the application is respectfully requested. Claims 3-4 and 7 were objected to. The claims
 5 have now been corrected and should be in full conformance. The claims contain no new matter. The added claim limitations are clearly shown, for example, in Figs. 1 and 3 and pages 7-8 of the PCT application no. PCT/SE2003/001403.

Claims 1-8 were rejected as being obvious under
 10 Section 103 over Gafni in view of Ingman. This rejection is respectfully traversed.

Gafni merely discloses an apparatus for measuring threshold sensitivity to stimulus. Fig. 3 shows peltier elements 60 in operative engagement with a heat exchanger 66.
 15 A conduit 42 is used to carry cooling fluid to the probe 10 that is insulated with an insulating rubber material 68.

The Examiner correctly states in paragraph 11 on page 3 of the Office action that Gafni fails to disclose the housing in operative engagement with a roller. However, this
 20 is not what the amended claim 1 requires. More importantly, Gafni fails to teach or suggest a roller having peltier elements disposed inside the roller. Gafni also fails to teach a cool surface of the peltier element in operative engagement with an inside surface of the roller to cool the
 25 roller.

Ingman fails to cure these deficiencies. Ingman merely discloses a skin gripper. The skin grippers 182 (best

shown in Fig. 12B) is positively charged and are adhered to the negatively charged skin surface. Paragraph 0137 explains that a power supply provides a voltage difference V i.e. a gripping voltage between the conducting layer and the skin.

5 Paragraphs 159-160 explain that the gripping voltage is applied between the conducting layer 72 and the skin 66 such that gripping surface 70 is held firmly to the skin 66 to massage the skin. Paragraph 223 details that the skin grippers 182 have strip conductor 186. The conductors 186 are
10 positively charged to create the gripping voltage between the positive conductors 186 and the negatively charged skin, as best shown in Fig. 12B. The creation of the attracting forces between the skin and the electrically charged conductors is thus an essential feature of Ingman's invention.

15 On page 3 of the Office action, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the sensor device of Gafni to have the housing in operative engagement with a roller as taught by Ingman "to provide a device that effectively engages the
20 skin." Applicants respectfully disagree.

The Requisite Steps of Independent Claim 1 Are Neither Taught Nor Suggested in the Cited Art.

25 The current amended claim 1 recites, among other method steps, a peltier element disposed inside the roller and the cooled surface being in operative engagement with an

inside of the roller to cool the roller. Such features are not taught or suggested in the cited references.

As indicated above, Gafni does not teach or suggest the roller at all. Gafni also fails to teach a peltier element disposed inside the roller and the cooled surface in operative engagement with an inside surface of the roller. Ingman does not cure these deficiencies. Ingman merely teaches a roller that has a positively charged outer surface to be adhered or attracted to the negatively charged skin of the user. Ingman completely fails to teach or suggest the use of peltier elements let alone peltier elements disposed inside the roller.

Accordingly, the combination of the cited references fails to teach, suggest or provide motivation or incentive for this aspect of the invention. Therefore, the rejection of claim 1 under § 103(a) is improper, and should be removed.

b. Prima Facie Support for Combination Under § 103 Not Provided

Even assuming *arguendo* that the requisite method steps of claim 1 are shown by the combination of Gafni and Ingman, *prima facie* support for combining the references, according to the requirements as set forth in M.P.E.P. § 2142 has not been provided in the present Office Action.

As provided in M.P.E.P. § 2142, the Supreme Court in *KSR International v. Teleflex Inc.*, 82 USPQ2d 1385, 1396

(2007) specified that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. “[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Furthermore, the Examiner must make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art” (KSR, page 14).

The only rationale provided in support of the 103(a) rejection of claim 1 is at the bottom of page 3 of the Office action, which merely asserts the combination would have been obvious it would “provide a device that effectively engages the skin.” (emphasis added). Thus, the benefit, or advantage of the modification is the only rationale provided in the Office Action in support of the instant rejection.

However, merely stating that the benefit of the modification exists, as done above, does not provide the “articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness, required under KSR. By definition, every patentable invention must be “beneficial” – and *arguendo* every invention contemplates at

least some new benefit(s) in arriving at the invention -
 certainly this does not render the benefit obvious or
 expected. Because every modification or element has a
 corresponding use or benefit, the above reasoning could be
 5 applied to any improvement. It appears therefore that
 "hindsight construction" may have perhaps played a role in
 arriving at the present ground for rejection in the Office
 action - which though difficult perhaps to avoid in many
 cases, is nonetheless impermissible in making a *prima facie*
 10 showing of obviousness.

According to M.P.E.P. 2142, "the examiner bears the
 initial burden of factually supporting any *prima facie*
 conclusion of obviousness. If the examiner does not produce a
prima facie case, the applicant is under no obligation to
 15 submit evidence of nonobviousness." Because a *prima facie*
 conclusion of obviousness has not been provided in the present
 Office Action, Applicants respectfully request reconsideration
 and withdrawal of this ground for rejection as to claim 1, and
 any additional remaining claims to the extent they may depend
 20 therefrom.

In view of the above, it is respectfully submitted
 that the amended claim 1 is allowable.

Claims 2-8 are submitted to be allowable because the
 claims depend upon the allowable base claim 1 and because each
 25 claim includes limitations that are not taught or suggested in
 the cited references.

Claims 9-11 were rejected as being obvious under Section 103 over Gafni. This rejection is respectfully traversed.

The amended claim 9 now requires that the housing
 5 has an enlarged cooling segment with outwardly protruding
 flanges that completely surrounds the peltier element and that
 the cooling segment is made of a material with a high heat-
 conductivity. It is submitted that none of the cited
 references teaches or suggests these limitations together with
 10 all the other limitations of the amended claim 9.

Gafne, in contrast, teaches surrounding the peltier
 elements 60 and the heat exchanger 66 with insulation 68, such
 as rubber, for maintaining the temperature of the heat
 exchanger 66 and for providing a housing to probe unit 10 (see
 15 col. 3, lines 43-47). By definition an insulating material
 has an extremely low heat-conductivity. The substitution of
 the insulation 68 to another material that has a high heat-
 conductivity would not maintain the temperature of the heat
 exchanger 66 as required by Gafne in col. 3, line 44-45.
 20 Additionally, Gafne completely fails to teach or suggest an
 enlarged cooling segment with outwardly protruding flanges.

Applicants fail to see why a person of ordinary
 skill in the art would look to Gafne to learn about
 surrounding the peltier elements with a high heat-conductivity
 25 material and using an enlarged cooling segment with outwardly
 protruding flanges when Gafne completely fails to teach or

suggest these features. In fact, it is submitted that Gafne teaches away from surrounding the peltier elements with a high heat-conductivity material since he teaches that an insulating material (thus a material with a low heat-conductivity) should
5 be used to maintain the temperature in the heat exchanger 66.

It is submitted that Gafne would require extensive modifications that are not taught or suggested in the cited documents to meet all the requirements of the amended claim 9.

In view thereof, it is submitted that the amended
10 claim 9 is allowable over the cited references.

Claims 10-11 are submitted to be allowable because the claims depend upon the allowable base claim 9 and because each claim includes limitations that are not taught or suggested in the cited references.

The application is now submitted to be in condition
for allowance, and such action is respectfully requested.

5

Respectfully submitted,

FASTH LAW OFFICES

/rfasth/

Rolf Fasth

Registration No. 36,999

10

Attorney docket number: 388.885USN

FASTH LAW OFFICES

26 Pinecrest Plaza, Suite 2

15 Southern Pines, NC 28387-4301

Telephone: (910) 687-0001

Facsimile: (910) 295-2152

Email: rolf.fasth@fasthlaw.com

20